

S.M



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,923	04/12/2001	Alex Holtz	1752.0140001	5236

26111 7590 09/26/2002

STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, N.W., SUITE 600
WASHINGTON, DC 20005-3934

EXAMINER

SOTOMAYOR, JOHN

ART UNIT	PAPER NUMBER
----------	--------------

3714

DATE MAILED: 09/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

S.M.

Office Action Summary

Application No.

09/832,923

Applicant(s)

HOLTZ ET AL.

Examiner

John L Sotomayor

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 9/03/02 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.
- Patent Applications*
- JLL*
9/17/02

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in–

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claims 1-3, and 8-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Owens et al (US 6,315,572).
4. Regarding claim 1, Owens et al discloses a networked system for sending lessons to a plurality of students to be displayed at a remote site with bi-directional means of communicating with the student (Col 5, lines 20-33 and Fig 1), a multimedia production means for communicating with production devices in response to a signal from the tutorial processing

Art Unit: 3714

means or client apparatus (Col 5, lines 34-50), and network communication means for supporting bi-directional communications with the user (Col 25, lines 27-41).

5. Regarding claim 2, Owens et al discloses an authoring system for the generation of testing multimedia files that are delivered to the student (Col 5, lines 34-42), an evaluation means for determining the performance of the student on the test (Col 5, lines 61-67 and Col 6, lines 1-2), and post-test guidance through a feedback from the student's performance and the delivery of study guides on a demand basis (Col 15, lines 43-55).

6. Regarding claims 3 and 12, Owens et al discloses a system and method of computerized authoring, learning and evaluation that supports bi-directional communication via network means, including the Internet (Col 25, lines 27-57).

7. Regarding claim 8, Owens et al discloses a method for training in which a study guide may be requested and sent to a student covering any data previously sent in a test (Col 15, lines 43-55).

8. Regarding claim 9, Owens et al discloses a system and method in which lesson tests are compiled and sent to students (Col 5, lines 20-34).

9. Regarding claim 10, Owens et al discloses an evaluation means for determining the performance of the student on the test (Col 5, lines 61-67 and Col 6, lines 1-2).

10. Regarding claim 11, Owens et al discloses a method for training in which a study guide may be requested and sent to a student covering any data previously sent in a test based upon previous performance on a test (Col 5, lines 61-66 and Col 15, lines 43-55).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 4-5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al.

15. Regarding claim 4, Owens et al discloses a learning system with an authoring method that allows the generation and transmission over networked communications of lesson and

Art Unit: 3714

testing materials (Col 5, lines 20-51), receiving data from the student in response to the transmission of such materials and processes the data according to programmed instructions (Col 5, lines 57-66), and providing feedback to the student (Col 15, lines 43-55). Owens et al does not specifically disclose that the lesson sent to the student contains an assignment to prepare pre-production instructions to operate a media production device. However, Owens et al describes an authoring system in which multimedia files are linked to one another by context or relation (Col 5, lines 52-56) and shows that the authoring system has a built in relationship generator for use after a topic for a lesson has been selected (Col 11, lines 62-67 and Col 12, lines 1-18). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to produce a lesson with an assignment to the student to prepare pre-production instructions for a media production device if the media device were the topic chosen and presented to the authoring system as discloses by Owens et al.

16. Regarding claim 5, Owens et al discloses an authoring system in which multimedia files are linked to one another by context or relation (Col 5, lines 52-56) and shows that the authoring system has a built in relationship generator for use after a topic for a lesson has been selected (Col 11, lines 62-67 and Col 12, lines 1-18). Owens et al does not specifically disclose that the authoring system defines directions to prepare a script or a set of media production commands for the script. However, text information in script format is one of the objects used by a lesson to convey conceptual information as provided to the student by the authoring system along with media commands associated with the text script (Col 7, lines 51-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide an authoring

Art Unit: 3714

system with multimedia capabilities capable of producing directions to prepare a script and media production commands corresponding to said script.

17. Regarding claim 7, Owens et al discloses an authoring system in which multimedia files are linked to one another by context or relation (Col 5, lines 52-56) and shows that the authoring system has a built in relationship generator for use after a topic for a lesson has been selected (Col 11, lines 62-67 and Col 12, lines 1-18). Owens et al does not specifically disclose that multimedia production lessons built by the authoring system comprise text, video graphics and animation related to a media production topic. However, Owens et al does disclose an authoring system capable of using text, sound and graphics such as digitized images, still and moving images relating to a central topic (Col 5, lines 37-40) and capable of allowing a user to selectively broaden a user's knowledge of a selected area (Col 6, lines 5-8) for use in preparing lessons and tests to be sent over networked means to a user. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide the capability to produce media production lessons comprising text, video graphics and animation related to a media production topic and sent over networked means to a user.

18. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al in view of Peters (US 5,577,190). Owens et al discloses an authoring system in which multimedia files are linked to one another by context or relation (Col 5, lines 52-56) and shows that the authoring system has a built in relationship generator for use after a topic for a lesson has been selected (Col 11, lines 62-67 and Col 12, lines 1-18). Owens et al does not specifically disclose a system with a set of media commands that includes transmit multimedia segments, assign transition effects, send text to a teleprompting means, and control camera shots. However, Peters

Art Unit: 3714

teaches a network capable media editing system with adjustable source material that includes the generation of media commands such as motion effects, text effects and transition effects (Col 8, lines 33-43). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide a multimedia lesson authoring system with the capability to produce media production commands that includes transmit multimedia segments, assign transition effects, send text to a teleprompting means, and control camera shots. Modifying the authoring system disclosed by Owens et al with the capability taught by Peters provides a more robust system for the production and dissemination of network multimedia production.

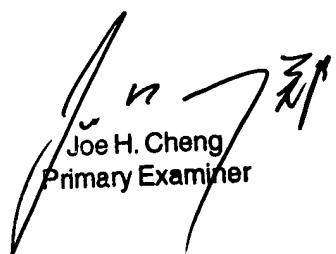
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L Sotomayor whose telephone number is 703-305-4558. The examiner can normally be reached on 6:30-4:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7768 for regular communications and 703-308-7768 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4558.

jls
September 17, 2002


Joe H. Cheng
Primary Examiner